

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD E. H. KENNEY

Appeal No. 1998-3316
Application No. 08/203,300

HEARD: NOVEMBER 7, 2001¹

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 9. Claims 10 through 18 stand withdrawn. As a consequence of the cancellation of objected to claims 2 and 3, following the introduction (Paper No. 25) and then withdrawal (Paper No. 28) of a new ground of rejection for these claims,

¹ Receipt is acknowledged of appellant's "POST HEARING CLARIFICATION" (Paper No. 37).

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claims 1 and 4 through 9 constitute all of the claims before us for review.

Appellant's invention pertains to a print holder. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the main brief (Paper No. 24).

As evidence of obviousness, the examiner has applied the documents listed below:

Lyman	4,271,618	Jun. 9,
1981		
Pougher	568,168	Mar. 21,
1945		
(Great Britain)		

The following rejection is before us for review.

Claims 1 and 4 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pougher in view of Lyman.

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The full text of the examiner's rejection and response to the argument presented by appellant appears in the main and supplemental answers (Paper Nos. 25 and 28), while the complete statement of appellant's argument can be found in the main, reply and supplemental reply briefs (Paper Nos. 24, 27, and 29).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellant's specification, drawings, and claims, the applied teachings,² and the respective viewpoints of

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We cannot sustain the rejection of appellant's claims under 35 U.S.C. § 103 based upon the applied reference combination. Our reasoning appears below.

Claim 1 is drawn to a print holder comprising, inter alia, front and rear molded transparent plastic pieces, each piece comprising a generally planar upright portion having side edges permanently united together, a central portion of at least one of the pieces having an inwardly recessed portion defining with the other piece a generally continuous uninterrupted pocket having an upper opening at an upper end, and a lower opening of a length less than the length of the upper opening, whereby a sheet member can be inserted and retained in the pocket and may be dislodged upwardly through the upper opening by applying a thin bladed rod through the lower opening.

We turn now to the evidence of obviousness.

The Pougher reference (Fig. 7) teaches a frame for photographs made from transparent plastic material. The frame provides a trough for photographs, which photographs are viewable through the side walls of the frame. A plain sheet of material (partition) may extend between the photographs (page 3, lines 38 through 40). A person's fingers can engage upper ends projecting

slightly above the trough for withdrawal purposes (page 3, lines 26 through 34).³

The Lyman reference discloses a frame construction that includes two identical frame assemblies hinged together, each molded of transparent plastic material (column 2, lines 11 through 25). When two panels 42 of each assembly (Figs. 2 through 4) are ultrasonically welded together, pairs of parallel narrow surfaces register with one another, and the panels are spaced apart slightly a sufficient distance to receive a pair of photographs. Interrupted shoulders 58 along

³ As indicated in this reference (page 3, lines 26 through 28), a closure for the upper end of the trough may be omitted.

bottom edges (not at top edges) prevent pictures introduced at the top from falling out. A slot 70 in the middle of the bottom edge enables a thin implement to be inserted in the space between the panels to eject pictures when desired (column 3, lines 10 through 29).

From our perspective, the Lyman patent (Figs. 2 through 4) is a highly relevant document in revealing the knowledge in the art, at the time of appellant's invention, of the known fabrication practice of forming a picture frame by the ultrasonic welding together of two identical, molded transparent plastic frame members yielding a frame with a slot at its bottom such that a thin implement inserted therein can be used to eject pictures through an opening in the top of the frame. However, when we collectively consider the two references relied upon by the examiner, the difficulty we readily perceive is that the only apparent motivation to rework the particular one-piece clear synthetic plastic frame (Fig. 7) disclosed by Pougher (a frame moulded with a trough open at the upper end and having an integral base or foot forming a stand) stems from an inappropriate reliance upon

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appellant's own teaching and hindsight. It is for this reason that we cannot sustain the rejection on appeal.

As a showing of commercial success, appellant has proffered the declaration of Richard E. H. Kenney (inventor), executed March 7, 1996, Exhibits 1 through 11, the declaration of Richard E. H. Kenney (inventor), executed July 23, 1997 (Exhibit 12), the declaration of Neal A. Parker, executed October 7, 1997 (Exhibit 13), and the declaration of Gerald A. Conway executed July 17, 1997 (Exhibit 14). Since we have determined, supra, that the particular rejection on appeal is not sound, we need not comment upon the content of appellant's submissions.

The decision of the examiner is reversed.

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REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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COHEN

APPEAL NO. 1998-3316 - JUDGE

APPLICATION NO. 08/203,300

APJ COHEN

APJ McQUADE

APJ FRANKFORT

DECISION: REVERSED

Prepared By:

DRAFT TYPED: 20 Aug 02

FINAL TYPED: